

6

REMARKS

Claims 1 – 18 remain in this application; claims 1, 11 and 15 have been amended.

The Examiner is complimented on his highly imaginative use of eight inapposite references in a variety of combinations, assembled after reading Applicant's specification, to conclude that all 18 of Applicant's claims are "obvious".

Claim 15 was objected to for erroneously including "psig". Amendment has corrected that to the more accurate "gpm".

Applicant has invented a process and apparatus for sterilizing contaminatable slurries, as defined by Applicant at p. 8, 1st paragraph: "such as kaolin, calcium carbonate, titanium dioxide, talc, latex, other carbonates, and combinations thereof, which are subject to contamination by aerobic and anaerobic bacteria, and which are used as coatings, fillers, extenders and pigments in the paper, paint, rubber and plastics industries."

Independent claims 1 and 11 have been amended to recite that the piping in the Applicant's process/apparatus for sterilizing contaminatable slurries "to exclude aerobic and anaerobic bacteria", and that the piping circuit is "oxygen-free". To preclude aerobic bacteria, the system is and must be oxygen-free; see p. 5, 2nd full paragraph: "Oxygen is purged from the system by the simultaneous introduction of nitrogen from a supply 50 via a nozzle 52."

Claim 11 was rejected under 35 USC §102 as anticipated by Bunin. Bunin relates a process for sterilizing "infectious waste", not "contaminatable slurries" as claimed by Applicant. Applicant does not claim to have invented sterilization, just sterilization of the contaminatable slurries defined in his application, thus solving a persistent problem in the relevant art of kaolin and

the like slurries. Bunin relates to a completely different art, that of sterilizing infectious waste headed for a landfill. In contrast, Applicant sterilizes the industrially-useful slurries set forth in his specification (see above).

Applicant solves a completely different problem than does Bunin. Bunin starts with solid waste material 2, which is comminuted in a grinder 6 and then infused with an aqueous stream 11, which may be "sewage effluent". An essential part of his process is creating a slurry. Applicant treats an existing slurry. Applicant excludes oxygen from his process. Bunin intentionally adds air, via his 2-stage hot air injectors 21 and 22, which also "provide needed agitation...and helps propel the slurry further within pipe section 28" (col. 4, lines 10-15). In contrast claim 11 recites "a pump for intaking unsterilized slurry and pumping slurry through the piping circuit at a predetermined pressure at a predetermined flow rate."

Thus, we see that Bunin is directed to a different art, and does not contain the structure recited in claim 11, thus failing to anticipate claim 11. Accordingly, the Examiner is requested to reconsider and withdraw this ground of rejection.

Claims 1, 3, 4 and 8 were rejected under 35 USC §103 as obvious over the combination of Bunin and Aikus. The failure of Bunin as a reference are detailed immediately above, and apply equally here.

The Examiner alleges that Aikus supplies the operating temperature, the second heat exchanger, and predetermined flow rate of claim 1. Aikus has no disclosure of sterilizing a contaminatable slurry as defined by Applicant. Not all sterilization processes are equal, as Aikus points out in his "Background of the Invention" section. There he states that food processing sterilization is not suitable for the pharmaceutical industry, because there are "different standards and requirements". So, too the process he discloses for pharmaceutical industry is not suitable for Applicant's recited "paper, paint,

rubber and plastics industries." Again, Applicant is sterilizing industrially useful slurries, while Aikus deals with pharmaceutical sterilization of parenteral liquids (not slurries) or human and animal consumables.

Aikus is from a completely different industry than Bunin. Even if there were, there is no disclosure of the problem addressed by Applicant: Sterilization of contaminatable slurries, *as defined in the specification*. Nowhere in either reference is there a disclosure that the fluid handling system is oxygen-free or that such is desirable. Neither reference states or suggests that there is a need to preclude both aerobic and anaerobic bacteria from a slurry. Reconsideration and withdrawal of this ground of rejection is requested.

Claims 2 and 5 – 7 were rejected under 35 USC §103 as obvious over the combination of Bunin and Aikus, plus Rechtsteiner and Grimberg. The new references allegedly supply tank sterilization recitations of the claims. Neither reference discloses either any apparatus or process of sterilizing a contaminatable slurry, as defined by Applicant. Both relate to tank sterilization. Again, Applicant did not invent tank sterilization, but this is a portion of his inventive apparatus and process for sterilizing "contaminatable slurries".

Claim 9 was rejected under 35 USC §103 as obvious over the combination of Bunin and Aikus, plus Camden. Claim 17 was rejected under 35 USC §103 as obvious over the combination of Bunin and Dietrich, while claim 18 was similarly rejected on Bunin and Acernese. Bunin and Aikus fail as explained above. Camden, Dietrich and Acernese also fail to disclose either the problem addressed by Applicant, or the solution proposed in claims 9, 17 or 18.

Without the guidance of Applicant's specification, there is no incentive to combine the eight separate references in the various combinations set forth. It

is axiomatic that it may be possible to recreate any invention by looking at the enabling specification, and then searching all published patents to find all the various elements of the combination claimed, despite their irrelevance relative to each other or to the problem solved by Applicant, as here. It is quite significant that *none of the eight references cited by the Examiner relate in any manner to contaminatable slurries! Not a single reference!*

If that were the law, then everything would be obvious; it would be obvious to create the Internet by looking at a fishnet! If that were the law, the Patent Office would be out of business, since nothing would be patentable. Fortunately, the Courts read the law differently (emphasis added):

In In re Laskowski, 10 USPQ2d 1398 (CAFC - 1989), the Federal Circuit overturned an obviousness rejection similar to those asserted here by the Examiner. The Court cited several of its relevant prior pronouncements as follows:

"(t)he mere fact that the prior art could be so modified would not have made the modification obvious ***unless the prior art suggested the desirability of the modification.***", citing In re Gordon, 221 USPQ 1125, 1127 (CAFC - 1984);

"there must be ***some logical reason*** apparent from positive concrete evidence of record ***which justifies a combination*** of primary and secondary references", quoting In re Regel, 188 USPQ 136, 139 n.6 (CCPA - 1975) which cited In re Sternowski, 170 USPQ 343 (CCPA - 1971);

"obviousness can not be established by combining pieces of prior art ***absent some teaching, suggestion, or incentive*** supporting the combination", citing In re Geiger, 2 USPQ2d 1276 (CAFC - 1987); and

a remark on the "impropriety of hindsight reconstruction", citing In re Deminski, 230 USPQ 313, 316 (CAFC - 1986).

The Examiner has failed to identify any language in the cited prior art which teaches or suggests the combination claimed by Applicant. Nor is any positive, concrete evidence cited by the Examiner which justifies his combining of references to reject Applicants' claims.

For these reasons, the Examiner has failed to establish the "*prima facie* case of obviousness" required by the Court:

"The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. [citation omitted] It can satisfy this burden only by *showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine* the relevant teachings in the references. *In re Fine*, 5 USPQ2d 1596; 1598 (Fed. Cir. 1988).

It is submitted that the Examiner is committing the ancient sin of combining references in light of Applicants' disclosure.

Obviousness has certain parameters: there must be some reason to combine references, and the resulting the combination must meet the claims. Neither is found here.

It is submitted that, in view of the above arguments, Applicant's claims 1 - 18 are patentable over the art cited by the Examiner.

Respectfully submitted,

Paul E. Adler

By



David A. Greenlee, Attorney, Reg. No. 20825

P.O. Box 340557


Columbus, OH 43234-0557

Tel: 614.854.9150 fax: 614.854.9155

Docket 30427

April 22, 2004

This certifies that this document was transmitted via facsimile to USPTO, Art Unit 1744 at 703.872.9310 on April 22, 2004 by



David A. Greenlee